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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/615,582
Filing Date: July 07, 2003
Appellant(s): DARRELL, RICHARD A.

Irvin E. Branch (Reg. No. 42,358)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 25, 2008 appealing from the Office action mailed on February 27, 2008.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,397,194 B1	HOUVENER et al.	05-2002
2001/0029470 A1	SCHULTZ et al.	10-2001
6,282,552 B1	THOMPSON et al.	08-2001

(9) Grounds of Rejection

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The following ground(s) of rejection are applicable to the appealed claims:

(9a) Claim 18 is rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory Subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "**new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof**" (emphasis added).

Claim 18 of the disclosed invention is inoperative and therefore lacks utility.

Claim 18 merely recite elements of an apparatus or a system ("means for" corresponds to software program elements and not tangible hardware components) without showing any ability to realize functionality of the recited elements (i.e. functional descriptive material per se) and therefore is rendered inoperative lacking any utility.

Note that a computer (or software program) code cannot by itself perform the underlying function until it is loaded on some computer readable memory and accessed by the computer (or a processor). Functional descriptive material, per se, is not statutory. This is exemplified in *In re Warmerdam* 31 USPQ2d 1754 where the rejection of a claim to a disembodied data structure was affirmed. Thus a claim to a data structure, per se, or other functional descriptive material, including computer programs, per se, is not patent eligible subject matter.

As per Appellants arguments on page 9 of the response "While the elements may be implemented in software, this is not a requirement. The elements may also be implemented in hardware". The Examiner has interpreted the "means for" functionality in the claims broadly to correspond to software program elements. The statement "elements may also be implemented in hardware" is interpreted to mean that hardware is not a required part of the claimed system.

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(9b) Claims 1-5, 7, 9, 11-15 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Houvener et al (US Patent 6,397,194 B1) in view of Schultz et al (US Pub. No. 2001/0029470 A1).

Claims 1 and 11, Houvener discloses a method and system of presenting an image of a receipt to a consumer, the method comprising: electronically capturing a receipt (See Houvener Column 1 lines 15-25); storing the receipt at a host computer system (See Houvener 1 Column lines 15-25 and Column 5 lines 37-41); receiving a request at the host computer system from a computer of the consumer to display the image of the receipt (See Houvener Column 10 lines 48-52, the user is interpreted to include the consumer); and transmitting an electronic file comprising the image of the receipt for display at the consumer computer (See Houvener Column 10 lines 58-62, the display device is interpreted to include display at the consumer computer). The host system, interface, a user computer are inherent in the disclosure of Houvener.

Houvener fails to teach the steps wherein the electronic file further comprises programming that causes at least one purchase item included on the receipt to appear as a selectable link to obtain more detailed information about item; receiving from the consumer computer information that defines at least one user-defined category based on product information; receiving a request at the host computer from the consumer computer to display a categorical listing of items purchased by the consumer, wherein the items are comprised by a plurality of receipts; for each of the plurality of receipts, consulting a database for product information relating to each item of the receipt; using the product information to sort the items into categories comprising the at least one user-defined category; and transmitting a second

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electronic file from the host computer system to the consumer computer, wherein the file comprises a listing of the items sorted into categories comprising the at least one user-defined category based on product information for display at the consumer computer.

Schultz teaches the steps of receiving information from the consumer computer (See Schultz Paragraphs 37, 40, 58, 67, the limitation “information that defines at least one user-defined category based on product information” is not a positive recitation of the defining step and hence is not given patentable weight. The information that defines at least one user-defined category is interpreted as an intended use of the receiving step); wherein the electronic file further comprises programming that causes at least one purchase item included on the receipt to appear as a selectable link to obtain more detailed information about item (See Schultz Figures 1 and 9 and Paragraphs 28, 29, 35, 52-59); receiving a request at the host computer from the consumer computer to display a categorical listing of items purchased by the consumer, wherein the items are comprised by a plurality of receipts; for each of the plurality of receipts, consulting a database for product information relating to each item of the receipt; using the product information; and transmitting a second electronic file from the host computer system to the consumer computer, wherein the file comprises a listing of the items sorted into categories that include the at least one category based on product information for display at the consumer computer (See Schultz Figures 1 and 11 and Paragraphs 28, 29, 35, 37, 40, 52-59, 62, 65-67). The receipt organizer service sorts the receipts by categories selected (See Paragraphs 62 and 65). The limitation “to sort the items into categories comprising the at least one user-defined category” is interpreted as an intended use of the step of using the product information and hence not given patentable weight. The limitation “information that defines at least one user-defined

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category based on product information” is not a positive recitation of the defining step. This limitation describes the information received from the consumer computer and not the step of receiving the information. The step of receiving information from the consumer computer is performed regardless of whether the information defines or does not define at least one user-defined category. The limitation is interpreted as non-functional descriptive material because it does not further limit the step of receiving information from the consumer computer. The descriptive material referenced above is non-functional and is not given patentable weight because there is no non-obvious functional relationship between the descriptive material and the manipulative step of receiving. When a prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but prior art describes different descriptive material than the claim, then the descriptive material is non-functional. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the requisite process steps described in Houvener to any type nonfunctional data because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention. When a prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but prior art describes different descriptive material than the claim, then the descriptive material is non-functional. The examiner need not give patentable weight to descriptive material absent a new and non-obvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1034 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 70 U.S.P.Q.2d (BNA) 1862 (Fed. Cir. May 13, 2004).

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Both Houvener and Schultz are concerned with the problem of providing a user with user-friendly means for storing and retrieving receipts. It would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Houvener to include teachings of Schultz. The combination of the teaching taken as a whole suggests that users would have benefited from being able to store the transaction receipts electronically and gather information from stored receipts (See Schultz Paragraph 9).

Claim 18, Houvener discloses a system of presenting an image of a receipt to a consumer comprising: means for receiving an electronic image of a receipt (See Houvener Column 1 lines 15-25); means for storing the image (See Houvener 1 Column lines 15-25 and Column 5 lines 37-41); means for receiving a request from a computer relating to the consumer to display the image (See Houvener Column 10 lines 48-52, the user is interpreted to include the consumer); means for transmitting the image to the consumer computer (See Houvener Column 10 lines 58-62).

Houvener fails to teach the means for obtaining product information relating to an item on the receipt and means for categorizing a plurality of items on a receipt into user-definable categories according to the product information.

Schultz teaches the means for obtaining product information relating to an item on the receipt (See Schultz Figures 1 and 9 and Paragraphs 28, 29, 35, 52-59).

Both Houvener and Schultz are concerned with the problem of providing a user with user-friendly means for storing and retrieving receipts. It would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Houvener to include teachings of Schultz. The combination of the teaching taken as a whole suggests that users would

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have benefited from being able to store the transaction receipts electronically and gather information from stored receipts (See Schultz Paragraph 9).

Houvener fails to teach the means for categorizing a plurality of items on a receipt into user-definable categories according to the product information.

Official notice is taken that means for categorizing a plurality of items on a receipt into user-definable categories according to the product information is old and well known in the art. This also implies that user defined categories have been defined before. This helps the user to customize the view of the receipt according to user preferences.

It would have been obvious to one with ordinary skill in the art at the time the invention was made to modify Houvener to include this feature. The combination of the teaching taken as a whole suggests that users would have benefited from being able to customize the view of the receipt according to user preferences.

Claims 2 and 12, Houvener teaches the step wherein the receipt comprises a credit card receipt (See Houvener Column 2 lines 16-25).

Claim 3, Houvener teaches the step wherein the receipt comprises an image of the consumer's signature (See Houvener Column 1 lines 15-25).

Claim 4, Houvener teaches the step wherein the receipt is printed on paper at a point of sale and electronically capturing comprises scanning an image of the receipt to an electronic file (See Houvener Column 2 lines 23-27 and Column 1 lines 19-25).

Claims 5 and 13, Houvener teaches the step wherein electronically capturing comprises receiving a file from a point-of-sale device, wherein the file comprises an image of the consumer's signature (See Houvener Column 3 lines 24-48).

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Claim 7, Schultz teaches the steps of receiving a selection of the purchase item from the consumer; consulting a database for information about the item; and transmitting a file comprising the information to the consumer (See Schultz Figures 1 and 9 and Paragraphs 28, 29, 35, 52-59, 67).

Claim 9, Schultz teaches the step wherein the second electronic file comprises programming that causes at least one item to appear as a selectable link to more detailed information about the item (See Schultz Paragraphs 52-59 and 67).

Claim 14, Houvener teaches the step wherein the image capture device is further configured to convert image information captured from a receipt into data (See Houvener Column 1 lines 15-25 and Column 3 lines 24-35, whereby the data may appear in an electronic image of the receipt as a selectable link relating to the data (See Schultz Figures 1 and 9 and Paragraphs 28, 29, 35, 52-59).

Claim 15, Houvener teaches the step wherein the interface is configured to provide communication between the host computer system and at least one point-of-sale device (See Houvener Column 5 lines 42-45).

Claim 17, Schultz teaches the step wherein the identifier is selected from the group consisting of UPC and SKU (See Schultz Paragraph 67).

(9c) Claims 21 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz et al (US Pub. No. 2001/0029470 A1).

Claim 21, Schultz teaches a method of presenting receipt information to a consumer, comprising: receiving from a consumer computer information (See Schultz Paragraphs 37, 40, 58, 67, the limitation “information that defines at least one user-defined category” is an intended

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use language recitation of the defining step and hence is not given patentable weight); receiving a request at the host computer from a computer of the consumer to display a categorical listing of items purchased by the consumer, wherein the items are comprised by a plurality of receipts; for each of the plurality of receipts, consulting a database for information relating to each item of the receipt; using the information; and transmitting an electronic file from the host computer system to the consumer computer, the electronic file comprising a list of the items sorted into at least one user-defined category for display at the consumer computer (See Schultz Figures 1 and 11 and Paragraphs 28, 29, 35, 37, 40, 52-59, 62, 65-67, the categories have been defined by a user). The receipt organizer service sorts the receipts by categories selected (See Paragraphs 62 and 65). The limitation “to sort the items into categories comprising the at least one user-defined category” is interpreted as an intended use of the step of using the product information and hence not given patentable weight. Schultz does not explicitly teach the step of “information that defines at least one user-defined category”. However the limitation “information that defines at least one user-defined category” is not a positive recitation of the defining step. This limitation describes the information and not the step of receiving the information. The step of receiving information from the consumer computer is performed regardless of whether the information defines or does not define at least one category. The limitation is interpreted as non-functional descriptive material because it does not further limit the step of receiving information from the consumer computer. Hence the limitation “the consumer computer that defines at least one category based on product information” is not given patentable weight (See discussion of claim 1 for additional clarification of this rejection).

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Claim 23, Schultz teaches the step wherein the electronic file comprises programming that causes at least one item to appear as a selectable link to more detailed information about the item (See Schultz Paragraphs 52-59 and 67).

(10) Response to Argument

In response to Appellant's arguments on page 6 of the Brief "The Appellant maintains that the rejection of claim 1 under 35 U.S.C. § 103(a) is improper because the record has not established a *prima facie* case of obviousness. Specifically, the record has not properly followed the Graham factors to arrive at a showing that all claim elements exist in the prior art and has not established the relevant skill necessary to determine that it would have been obvious to combine the references. Moreover, there is no "clear articulation of the reasons(s) why the claimed invention would have been obvious," the Examiner respectfully disagrees. First of all as pointed out in *KSR v. Teleflex* 82 USPQ2d 1385, the prior art references need not teach or suggest all the claim limitations. Prior art is not limited to just the references being applied, but includes the understanding of one of ordinary skill in the art. The proper analysis of the claim is whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts. From the rejection of the claims discussed above and in the responses enlisted below, the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts. For the sake of brevity, these discussions have not been repeated. The motivation to combine is that users would have benefited from being able to store the transaction receipts electronically and gather information from stored receipts (as disclosed in Schultz Paragraph 9).

In response to Appellant's arguments on page 7 of the Brief that the Office Action fails to

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give patentable weight to "information that defines at least one user- defined category, the Examiner would like to reiterate the clarification made in the rejection above. The limitation describes the information received from the consumer computer and not the step of receiving the information. The step of receiving information from the consumer computer is performed regardless of whether the information defines or does not define at least one user-defined category. The limitation is interpreted as non-functional descriptive material because it does not further limit the step of receiving information from the consumer computer. The descriptive material referenced above is non-functional and is not given patentable weight because there is no non-obvious functional relationship between the descriptive material and the manipulative step of receiving. When a prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but prior art describes different descriptive material than the claim, then the descriptive material is non-functional. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply the requisite process steps described in Houvener to any type nonfunctional data because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention. When a prior art describes all the claimed structural and functional relationships between the descriptive material and the substrate, but prior art describes different descriptive material than the claim, then the descriptive material is non-functional. The examiner need not give patentable weight to descriptive material absent a new and non-obvious functional relationship between the descriptive material and the substrate. See *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1034 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 70 U.S.P.Q.2d (BNA) 1862 (Fed. Cir. May 13, 2004). In

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response to Appellant's "Moreover, the information is later used in sorting the items", the Examiner would like to point out that the step of sorting has only been recited as an intended use of "using the product information" step.

In response to Appellant's arguments on page 8 of the Brief that "the cited references could not be successfully combined to produce a working embodiment of the invention of claim 11. Houvener relates to scanning paper receipts. Schultz deals exclusively with electronic environments. There is no receipt generated by Schultz to be scanned by Houvener..... there is no teaching that allows Houvener to interface with Schultz, so the system produced by the combination would fail to function properly", the Examiner respectfully disagrees. As pointed out by the Appellants, Houvener relates to scanning paper receipts. Once the receipts are scanned, they become electronic receipts. Hence the teachings of Schultz can now be applied to the electronic receipts. Hence there is logical progression of technology by combining the teachings of the two references. The motivation to combine (has been explained in the rejection) is that users would have benefited from being able to store the transaction receipts electronically and gather information from stored receipts (as disclosed in Schultz Paragraph 9). This motivation would have been obvious to one of ordinary skill in the art.

In response to Appellant's assertion on page 8 of the Brief "The record cites Thompson as teaching user-defined categories, yet the Office Action states that "the user-defined categories are those selected by the user." User-selected categories are not, however, user-defined categories. Having to torture the term "user-selected categories" to include "user-defined categories" is a good indication that it was improper to take official notice of the claim element", the Examiner respectfully disagrees. In support for the Official notice taken (that means for

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categorizing a plurality of items on a receipt into user-definable categories according to the product information is old and well known in the art), the Examiner presented the Thompson et al reference (US Patent 6,282,552 B1). Thompson describes (in the Abstract and in Column 3 line 31 – Column 5 line 7) the feature of categorizing a plurality of items on a receipt into user-definable categories according to the product information. The product information are the telephone call information, the user-defined categories are those selected by the user. As described by Thompson in Column 4 lines 4-6, the user simply types in the new category description in a dialog box and the category is inserted as a category entry. This disclosure of Thompson clearly illustrates the feature of user-defined category. Hence the Thompson reference teaches the feature for which the official notice is taken.

In response to Appellant's arguments on page 9 of the Brief "The rejection of claim 21 includes a number of instances in which claim elements are not given patentable weight. The rejection refers to claim 1 for foundation. Since the Appellant has addressed the shortcomings of the rejection of claim 1 above, the Appellant directs attention to those arguments to identify the shortcomings of the rejection of claim 21. Specifically, the cases cited do not support the extension of "printed matter rejections" to other fields as is being attempted here", the Examiner would like to point out that Appellant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Appellant's other arguments have been fully considered but they are not persuasive.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Narayanswamy Subramanian/
Primary Examiner, Art Unit 3695

November 7, 2008

Conferees:

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